

## REMARKS

These remarks are in reply to the Office action mailed June 18, 2001. Claims 49-69 are presented herewith for consideration.

### Rejection of Claims 49-69 Under 35 U.S.C. § 103

Claims 49-69 have been rejected under 35 U.S.C. § 103 has been obvious over U.S. Patent No. 5,252,814 to Tooley (*Tooley*). Applicants traverse the rejection as follows.

*Tooley* discloses multi-scanner checkout counter for automated scanning of barcodes on merchandise items. The items are fed by a belt to an inclined and transparent digitizer panel. As the items slide or tumble down the digitizer panel, scanners above and below the panel scan the items to register the barcode located on the items.

In rejecting the claims under § 103, Applicants respectfully submit that the Examiner has mischaracterized the cited reference and applied incorrect standards of obviousness as set forth below.

#### A. *Tooley* Does Not Teach or Suggest a Personal Computer As Claimed

The Examiner has stated that *Tooley* discloses a personal computer including a microprocessor 44. Applicants respectfully submit that *Tooley* does not disclose a personal computer. Merriam-Webster's Online Dictionary defines a "personal computer" as:

a general-purpose computer equipped with a microprocessor and designed to run especially commercial software (as a word processor or World Wide Web browser) for an individual user.

*Tooley* clearly does not meet this definition. The disclosed system is not a general-purpose computer, and the disclosed system is not intended to run commercial software such as a word processor or web browser.

Therefore, Applicants respectfully submit that the invention recited in Claims 49-69 are not obvious over the cited reference.

B. *Tooley* Does Not Teach or Suggest a Processor and Separate Personal Computer As Claimed

In addition to the above, the Examiner has acknowledged that *Tooley* does not disclose a second processor as claimed, but states:

it would have been obvious to one of ordinary skill in the art that microprocessor 44 could include sub-processors, one dedicated to the detecting elements for encoding information and the other for processing executable code for recognizing said visual aspect and position.

The Examiner provides no support or basis for why this proposed modification would have been obvious. As such, Applicants respectfully submit that the Examiner has not met the burden of establishing obviousness under § 103. A rejection under § 103 requires not only express support, but the Examiner must make a specific showing of where the suggestion or motivation is found in the art to make the modification. *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998); *Heidelberger Druckmaschinen v. Hantscho Commercial*, 21 F.3d 1068, 1072 (Fed. Cir. 1994); *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987).

In making such a showing, it is not enough that the proposed modification was conventional. "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d

953, 957 (Fed. Cir. 1997). The fact that a reference can be modified is insufficient to meet this criteria. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998); *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990). The Federal Circuit in *In re Rouffet* elaborated on this requirement:

an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." (citation omitted).

*Id.* at 1357.

Therefore, it is not enough for the Examiner to simply state that the microprocessor 44 could be modified to include sub-processors, one for detecting information and one for executing code. The Examiner must show some teaching or suggestion, found in the art at the time of the invention to modify the microprocessor 44 to include sub-processors. Applicants respectfully submit that such a suggestion or motivation did not exist, and that any such modification is gleaned only from impermissible hindsight afforded by the present invention itself. As such, it is respectfully submitted that the invention recited in Claims 49-69 cannot be rejected as obvious over *Tooley*.

Moreover, even if *Tooley* were modified so that microprocessor 44 includes a sub-processor, this still would not meet the limitations recited in Claims 49-69. The claims recite a first processor, and a personal computer including a second processor. The modification proposed by the Examiner is that the microprocessor 44 "could include sub-processors." Therefore, even were the reference modified as proposed by

the Examiner, the modification still only shows a single processor, not the two processors as recited in the claims. Unless the modification shows all claim limitations, the claims are not properly rejected. All claim limitations are significant, and must be given weight and effect *vis-a-vis* the patentability of the claims. *Application of Saether*, 492 F.2d 849, 852 (CCPA 1974). If a claim limitation is not taught or suggested by the prior art, then that claim cannot be obvious over the prior art. *Application of Glass*, 472 F.2d 1388, 1392 (CCPA 1973).

C. *Tooley Does Not Teach or Suggest a Horizontal Surface As Claimed*

The Examiner has acknowledged that *Tooley* does not disclose a horizontal surface as recited in the claims. He has stated however that:

it would have been obvious to one of ordinary skill in the art that the *Tooley* detecting surface (30) need not be inclined for the identification of said visual aspect and position of said hand held objects. The inclined surface of *Tooley* is for the improvement in speed of the detecting process. It would have been obvious to one of ordinary skill in the art that without the inclination of the surface, the user of the system could hand-guide the hand-held objects over the detecting surface.

Applicants respectfully submit that *Tooley* does not teach or suggest a substantially horizontal surface. In particular, the problem addressed by *Tooley* was how to scan price codes without manual handling of the objects. *Tooley* states:

The positioning of the merchandise item adjacent the scanner requiring manual intervention by the operator takes time especially when several scanning passes are required to obtain a good read of the bar code label. It would be desirable to provide a scanning system which insures that the bar code label will be scanned automatically irrespective of the position of the bar code label to increase the speed of the checkout operation.

It is therefore a principal object of this invention to provide a checkout system which will scan a bar code label on a purchased merchandise item without

requiring the checkout operator to handle either the scanning system or the merchandise item during a scanning operation.

It is another object of this invention to provide a checkout system employing a plurality of bar code scanning apparatuses for scanning a bar code label attached to a merchandise item allowing the scanning apparatuses to scan the bar code label without the checkout operator handling the merchandise item during the scanning operation.

Therefore, the reference expressly teaches away from the use of hands to guide the items past the scanners. In order to move the merchandise past the scanners, the surface of the digitizer panel 30 must be inclined with a sufficient slope so that even objects with a high coefficient of friction will slide or tumble down the slope.

Thus, there is no suggestion or motivation found in the art to substitute a horizontal surface for the sloped surface shown in *Tooley*. In fact, the reference clearly teaches away from a horizontal surface, which teaching is itself “persuasive evidence” of nonobviousness. *Monarch Knitting Machinery v. Sulzer Morat GmbH*, 139 F.3d 877, 882 (Fed. Cir. 1998); *In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997); *Kloster Steedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1573 (Fed. Cir. 1986). Without the impermissible use of the teachings of the invention itself, those of skill in the art would not have modified *Tooley* to include a horizontal panel.

#### Rejection of Claims 50 and 60 Under 35 U.S.C. § 103

Claims 50 and 60 have been rejected under 35 U.S.C. § 103 has been obvious over *Tooley*. Applicants traverse the rejection on the grounds that these claims depend on independent Claims 49 and 52, respectively. As explained above, several features of Claims 49 and 52 are not disclosed, and are not taught or suggested, in *Tooley*. Therefore, Claims 50 and 60 including those limitations cannot be considered

obvious over *Tooley*. It is therefore respectfully requested that the rejection on these grounds be withdrawn.

Rejection of Claims 51 and 61 Under 35 U.S.C. § 103

Claims 51 and 61 have been rejected under 35 U.S.C. § 103 has been obvious over *Tooley*. Applicants traverse the rejection on the grounds that these claims depend on independent Claims 49 and 52, respectively. As explained above, several features of Claims 49 and 52 are not disclosed, and are not taught or suggested, in *Tooley*. Therefore, Claims 51 and 61 including those limitations cannot be considered obvious over *Tooley*. It is therefore respectfully requested that the rejection on these grounds be withdrawn.

Rejection of Claims 53-56 and 62-65 Under 35 U.S.C. § 103

Claims 53-56 and 62-65 have been rejected under 35 U.S.C. § 103 has been obvious over *Tooley*. Applicants traverse the rejection on the grounds that these claims depend on independent Claims 49 and 52, respectively. As explained above, several features of Claims 49 and 52 are not disclosed, and are not taught or suggested, in *Tooley*. Therefore, Claims 53-56 and 62-65 including those limitations cannot be considered obvious over *Tooley*. It is therefore respectfully requested that the rejection on these grounds be withdrawn.

Rejection of Claims 57 and 69 Under 35 U.S.C. § 103

Claims 57 and 69 have been rejected under 35 U.S.C. § 103 has been obvious over *Tooley*. Applicants traverse the rejection on the grounds that these claims depend on independent Claims 49 and 52, respectively. As explained above, several

features of Claims 49 and 52 are not disclosed, and are not taught or suggested, in *Tooley*. Therefore, Claims 57 and 69 including those limitations cannot be considered obvious over *Tooley*. It is therefore respectfully requested that the rejection on these grounds be withdrawn.

Moreover, as discussed above, unsupported statements as to the obviousness of a claim over a cited reference are insufficient. The Examiner must specifically point out where the suggestion or motivation is found in the art to make the proposed modification.

Rejection of Claims 58, 59, 67 and 68 Under 35 U.S.C. § 103

Claims 58, 59, 67 and 68 have been rejected under 35 U.S.C. § 103 has been obvious over *Tooley*. Applicants traverse the rejection on the grounds that these claims depend on independent Claims 49 and 52, respectively. As explained above, several features of Claims 49 and 52 are not disclosed, and are not taught or suggested, in *Tooley*. Therefore, Claims 58, 59, 67 and 68 including those limitations cannot be considered obvious over *Tooley*. It is therefore respectfully requested that the rejection on these grounds be withdrawn.

Moreover, the Examiner has stated it would have been obvious to provide a communication link between the first and second sub-processors of *Tooley*. However, *Tooley* does not even disclose first and second sub-processors, let along a communication link therebetween.

Furthermore, as discussed above, unsupported statements as to the obviousness of a claim over a cited reference are insufficient. The Examiner must specifically point out where the suggestion or motivation is found in the art to make the proposed modification. For example, Applicants respectfully submit that wireless

communication was not well known at the time of the invention. The Examiner must show how a skilled artisan would have known to modify *Tooley* with wireless communication. Again, as *Tooley* discloses only a single processor, it is respectfully submitted that such communications would not have been considered obvious.

Rejection of Claim 66 Under 35 U.S.C. § 103

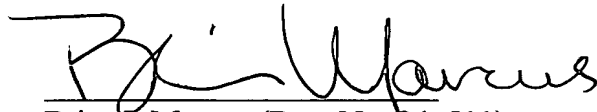
Claim 66 has been rejected under 35 U.S.C. § 103 has been obvious over *Tooley*. Applicants traverse the rejection on the grounds that this claim depends on independent Claim 52. As explained above, several features of Claim 52 is not disclosed, and is not taught or suggested, in *Tooley*. Therefore, Claim 66 including those limitations cannot be considered obvious over *Tooley*. It is therefore respectfully requested that the rejection on these grounds be withdrawn.

Based on the above, it is respectfully requested that the rejection of Claims 49-69 be withdrawn.

Should further questions remain, the Examiner is invited to contact the undersigned attorney by telephone.

Respectfully submitted,

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Brian I. Marcus (Reg. No. 34, 511)  
VIERRA MAGEN MARCUS  
HARMON & DENIRO LLP  
(415) 369-9660 ext. 205